



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,698	12/01/2004	Andreas Popp	29827/40662	6906
4743 7590 12/21/2006 MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			EXAMINER NUTTER, NATHAN M	
			ART UNIT	PAPER NUMBER
			1711	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/21/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/516,698

Applicant(s)

POPP ET AL.

Examiner

Nathan M. Nutter

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 19-21 and 23-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 19-21 and 23-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08) -
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Art Unit: 1711

DETAILED ACTION

This application has been re-assigned to Examiner Nathan M. Nutter in Art Unit 1711. All inquiries regarding this application should be directed to Examiner Nutter at telephone number 571-272-1076.

Response to Amendment

In response to the amendment filed 16 October 2006, the rejection of claims 1-16, 19-21 and 23-30 under 35 U.S.C. 102(b) as being anticipated by Gartner et al (US 5,506,324), Nowakowsky et al (US 4,873,299), Cohen et al (US 3,380,831) or Faul et al (US 5,661,220), is hereby expressly withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16, 19-21, and 23-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gartner et al (US 5,506,324) or Nowakowsky et al (US 4,873,299), both previously cited.

The reference to Gartner et al shows the production of (meth)acrylate esters of polyalkoxylated trimethylolpropanol, as herein claimed. Note column 4 (line 20) through column 5 (line 52) for the basic process which comprises a starting material of trimethylolpropane to which alkylene oxide chains, in blocks of ethylene oxide and

Art Unit: 1711

propylene oxide, are reacted, with subsequent esterification with (meth)acrylic compounds. Further, note column 7 (line 49) to column 10 (line 27).

The reference teaches the compositions as known. The constituents employed are all disclosed and the motivation to combine such is provided. As such, the artisan would have a high level of expectation to succeed at producing the instantly claimed invention from the teachings of the reference to Gartner et al.

The reference to Nowakowsky et al shows the production of (meth)acrylate esters of polyalkoxylated trimethylolpropanol, as herein claimed. Note column 3 (lines 4-29) for the basic process which comprises a starting material of trimethylolpropane to which alkylene oxide chains, in blocks of ethylene oxide and propylene oxide, are reacted, with subsequent esterification with (meth)acrylic compounds.

The reference teaches the compositions as known. The constituents employed are all disclosed and the motivation to combine such is provided. As such, the artisan would have a high level of expectation to succeed at producing the instantly claimed invention from the teachings of the reference to Nowakowsky et al.

Response to Arguments

Applicant's arguments filed 16 October 2006 have been fully considered but they are not persuasive.

With regard to the rejection of claims 1-16, 19-21, and 23-30 under 35 U.S.C. 103(a) as being unpatentable over Gartner et al (US 5,506,324), it is pointed out that the reference is taken for the entirety of its teachings and not for solely what the

Art Unit: 1711

Examples show. The reference shows the production of esters as claimed herein. The reference teaches the polyalkoxyl blocks at column 4 (lines 36-37). The inclusion of particular segments would be within the skill of an artisan desirous to promote certain features such as water solubility parameters, or other characteristics associated with the particular block units. Since the compositions are otherwise deemed to be employed for identical or similar (hydrogel). The reference is deemed to show sufficient motivation to produce the instantly claimed invention. It is pointed out that Example A at page 46 uses only ethylene oxide blocks, without propylene oxide blocks. Further, the minimum units of the alkyloxy blocks would be 18, not 15 for Example A. Only two examples, C and D, in Table 1 at page 47 have sufficient number of block units. However, it is questioned wherein the passage referred to states the inferiority of the absorption results, since it is not clearly stated. As such, this appears to be an incorrect conclusion without sufficient examples to show a proper comparison.

With regard to the rejection of claims 1-16, 19-21, and 23-30 under 35 U.S.C. 103(a) as being unpatentable over Nowakowsky et al (US 4,873,299), it is pointed out that the reference is taken for the entirety of its teachings and not solely for what is disclosed in the Examples thereof. It is not relevant that the reference refers to other cross-linking agents that are not within the scope of the instant claims. The reference shows the constituents and provides motivation to produce the claimed invention. The skilled artisan would have a high level of expectation of success from the teachings of the reference to produce the instantly claimed invention.

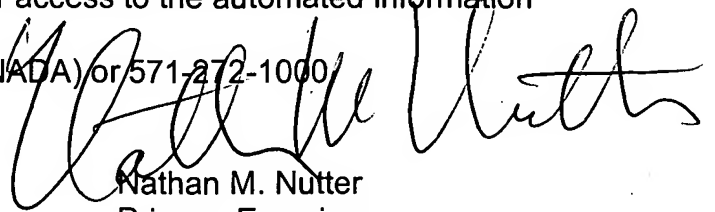
Art Unit: 1711

Due to the new grounds of rejection, this action is not being made FINAL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Nathan M. Nutter
Primary Examiner
Art Unit 1711

nmn

15 December 2006